

Remarks

This is in response to the Office Action dated November 10, 2004. Claims 1 and 2 are currently pending in the above-referenced application. In the November 10, 2004 Office Action, the Examiner rejected claims 1 and 2 under 35 U.S.C. § 103(a) in view of a single prior art reference, U.S. Patent No. 5,464,422 issued to Silverman (hereinafter *Silverman*).

The Examiner can satisfy his burden of establishing a *prima facie* case of obviousness “*only by showing some objective teaching* in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.”¹ In this case, the Examiner cites only one reference, *Silverman*, to render Claims 1 and 2 obvious. Modifying a single reference to support a determination of obviousness is improper absent a sufficient teaching or suggestion in the prior art to make such a modification.²

Here, it is uncontested that *Silverman* fails to disclose all of the claimed elements. According to the Examiner, “*Silverman* is silent as [to] the tapered ratios of the regions along the length of the needle.”³ Thus, the Examiner must point to some particular teaching or suggestion in *Silverman* that supports modifying the reference to have a needle with the claimed tapered ratios for the first and second regions of the tapered end. The Examiner has failed to cite any support in *Silverman* that suggests modifying the reference in such a manner because such a teaching does not exist.

Rather than point to some particular evidence in *Silverman*, the Examiner resorts to the alleged knowledge of skill in the art to modify the cited reference. Specifically, the Examiner

¹ *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988) (emphasis added).

² See *In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992) (stating that “[a]lthough couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious “modification” of the prior art”).

³ 11/10/2004 Office Action, p. 2.

alleges that because “*Silverman* set out to solve the same problem recognized by the [A]pplicant wherein strength is not sacrificed for a decrease in penetration force of the needle[,] [i]t would have been obvious to one having ordinary skill in the art to manufacture *Silverman*’s needle with the same tapered ratios along the length of the needle.”⁴ However, per the Court of Appeals for the Federal Circuit, “the Board cannot simply reach conclusions based on its own understanding or experience – or on its assessment of what would be basic knowledge or common sense.”⁵ “Rather, *the Board must point to some concrete evidence* in the record in support of these findings.”⁶

Here, *Silverman* may only be modified to render the claimed invention obvious if there is some *specific suggestion* in the prior art itself to modify the cited reference in the claimed manner. Again, *Silverman* is deficient of such a suggestion.⁷ Accordingly, the Examiner has failed to establish a *prima facie* case of obvious against Claims 1 and 2. For the reasons stated above, Applicant believes those claims, as currently pending, are in condition for allowance and respectfully requests reconsideration and allowance of Claims 1 and 2.

⁴ 11/10/2004 Office Action, p. 2.

⁵ *In re Zurko*, 258 F.3d 1379, 1386, 59 U.S.P.Q.2d 1693, 1697 (Fed. Cir. 2001). *See also In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (holding that the Board did not make out a proper *prima facie* case of obviousness when it modified a single reference without a specific motivation to make such a modification).

⁶ *Id.*

⁷ Assuming arguendo that *Silverman* set out to solve the same problem as the current Applicant, there is no suggestion in *Silverman* for solving the problem in the same manner as presently claimed by the Applicant.

Please charge any deficiency as well as any other fee(s) which may become due under 37 C.F.R. § 1.16 and/or 1.17 at any time during the pendency of this application, or credit any overpayment of such fee(s) to Deposit Account No. 50-2140. TWO (2) COPIES OF THIS SHEET ARE ENCLOSED

Respectfully submitted,

2/28/2005

Brian Lefort
Brian D. Lefort
Reg. No. 43,747
Attorney for Applicant

U.S. Surgical, a division of
TYCO HEALTHCARE GROUP LP
150 Glover Avenue
Norwalk, CT 06856
Phone: (203) 845-1358
Fax: (203) 845-4266